

USSN 10/802,990
Amendment and Response

CLAIM OBJECTIONS

The Examiner has rejected claim 20 (a use claim) under 35 U.S.C. 112, second paragraph, and under 35 U.S.C. 101. Applicants have remedied this objection by deleting without prejudice claim 20.

CLAIM AMENDMENTS

The Applicant has amended the claims as follows:

- (i) As indicated above, claim 20 as been cancelled with out prejudice.
- (ii) Claims 1 to 17 have been cancelled without prejudice.
- (iii) Independent claim 18 has been amended to specify that the composition further contains a primary metal hydrocarbyl dithiophosphate.
- (iv) New claims 21 to 35 have been added. New claims 21 to 35 are dependent on independent claim 18.

Support for the amendment to claim 18 is found in the specification as filed. For example, in claim 1 (now cancelled), in paragraphs 0011, 0013, 0027-0031, 0070, and Examples 1 to 4.

Support for new claims 21 to 35 are found in the claims as filed in claims 2 to 16 respectively.

Applicants submit that the amendment to the claims is fully supported by the specification and does not add subject-matter.

REMARKS AND AMENDMENTS

The Examiner has rejected claims 1-9, 11-12, 17 and 20 under 35 U.S.C. 102(b) as being anticipated by LeSuer (US 3,708,522). In view of the amendments made to the claims i.e., claims 1 to 17 have been deleted without prejudice, the 35 U.S.C. 102(b) rejection is obviated.

With regard to claim 18, the Examiner is of the position that it is novel over LeSuer because the Examiner has not raised a 35 U.S.C. 102(b) rejection to claim 18 in view of LeSuer. Thus new claims 21 to 35 will also be novel over LeSuer because they are dependent on claim 18.

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The Examiner has rejected claims 13 and 15-16 under 35 U.S.C. 103(a) as being unpatentable over LeSuer and Papay (US 5,652,201).

The Examiner has rejected claims 10 and 14 under 35 U.S.C. 103(a) as being unpatentable over LeSuer and Emert (US 5,498,809).

In view of the amendments made to the claims as set forth above, the 35 U.S.C. 103(a) rejection to claims 10, and 13-16 is obviated because the claims have been cancelled without prejudice.

With regard to new method claims 29, and 32-35 (substantially similar to claims 10 and 13-16, except claims 10 and 13-16 are dependent on a composition claim) the present invention is unobvious over both (i) LeSuer in view of Papay, and (ii) LeSuer in view of Emert, because neither rejection was raised by the Examiner over claim 18 that new method claims 29 and 32-35 are dependent on.

The Examiner has rejected claim 18 under 35 U.S.C. 103(a) as being unpatentable over LeSuer in view of Stewart (US 4,244,279). The Examiner contends the LeSuer discloses a lubricant with the composition of claim 18, but does not teach its use in a vehicle hydraulic system. The Examiner contends that Stewart discloses a lubrication system for a hydrostatic transmission. Thus it would have been obvious to one of ordinary skill in the art to use the lubricant of LeSuer and the hydrostatic transmission of Stewart. Applicants respectfully traverse.

As acknowledged by the Examiner, LeSuer does not teach, suggest or otherwise disclose that such a composition would be suitable for a hydraulic system. Further Stewart discloses hydrostatic hydraulic systems and only discloses that such systems require lubrication. Stewart does not teach, suggest, or otherwise disclose suitable chemistry for lubricating hydrostatic hydraulic systems. Thus a person skilled in the art would not be motivated to combine the teachings of LeSuer and Stewart.

A person of ordinary skill would not combine the teachings of LeSuer and Stewart with the expectation that such a combination would provide a hydraulic system as presently claimed with suitable performance. Such a combination would not have been contemplated

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with the expectation of success because a person of ordinary skill in the art would not be motivated to select the composition of LeSuer because there is not a disclosure or teaching or motivation to suggest that such a composition would be suitable for a hydraulic system. Further, Stewart does not teach, suggest or otherwise teach a lubricant containing (i) a substantially nitrogen free dispersant and/or (ii) a primary metal hydrocarbyl dithiophosphate.

In contrast, the present invention has unexpectedly discovered that the presently claimed hydraulic system is sufficiently lubricated to meet the objectives set further in the background section of Applicants' specification by employing a composition as defined in the present invention i.e., the composition comprises (i) a substantially nitrogen free dispersant and (ii) a primary metal hydrocarbyl dithiophosphate.

Further evidence to suggest the lack of motivation is found in the attached textbook (entitled "Chemistry and Technology of Lubricants", edited by Mortier and Orszulik) on page 245 and 246 indicate that:

"hydraulic systems, operate in various environmental atmospheres and sometimes at extreme pressures, requires a multitude of products of consistently varied properties" (see page 245); and

"The selection of the hydraulic lubricants and the specifically required properties depends on the hydraulic system operating conditions." (see page 246)

Given the teachings of the textbook, a person of ordinary skill in the art from common general knowledge would be aware that there is a multitude of known lubricants suitable for hydraulic fluids. Thus a person of ordinary skill in the art would be strongly motivated to employ a known hydraulic lubricant from the multitude of known hydraulic lubricants in a hydraulic system as defined by the present invention. Since, LeSuer does not teach, suggest, or otherwise disclose that the compositions disclosed therein are suitable hydraulic lubricants, a person skilled in the art would not have made such a combination.

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Hence Applicants submit that the present invention is unobvious in view of Stewart and LeSuer. Applicants respectfully request to Examiner to withdraw the 35 U.S.C. 103(a) rejection and find all claims allowable.

If for any reason the Examiner believes that a telephone conference would expedite the prosecution of this application, I can be reached at the telephone number listed below.

The Commissioner is authorized to charge any required fees or credit any overpayment of fees to The Lubrizol Corporation Deposit Account No. 12-2275.

Respectfully submitted,

THE LUBRIZOL CORPORATION

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